

## **REMARKS/ARGUMENTS**

Applicants have reviewed the Office Action of September 6, 2006. No claims have been amended. No claims have been cancelled. Claims 1-11, 13-18, and 20-35 are pending. Applicants request reconsideration.

Claims 1-8, 10, 11, 13-18, 20, and 21 were rejected under 35 U.S.C. 103(a) as obvious over Yang (5,704,858) in view of Talarico (5,951,420) and Walker (5,647,590). Applicants traverse the rejection.

Claim 1 requires the central core to have a coefficient of restitution (COR) of greater than about 0.45 to about 0.50 at 88 feet/second. On page 3, the Examiner stated that it would have been obvious to modify the COR of the central core to the recited limits because Applicants had not shown the criticality of the recited limits and it appeared the limits taught by Walker would accomplish similar purposes.

In response, Applicants submit that the recited limits are critical and Walker would not accomplish similar purposes. First, Applicants note that Yang, Talarico, and Walker are all directed towards safety balls. These references note that safety balls are different from regular softballs in that (1) they should be softer to avoid "sting"; and (2) they do not travel as far when hit. In particular, Walker desires a ball that does not travel as far so as to be suitable for urban use. See the last sentence of Abstract and col. 1, lines 10-15. To this end, Walker discloses a COR of less than 0.45 with a practical lower limit of about 0.30. He states that the softness of his core, associated with the lower COR, results in a ball that does not rebound off the bat as fast as a harder core ball, reducing its flight distance characteristics. In other words, Walker discloses the criticality of the recited limits. See col. 3, lines 23-31. On the other hand, the ball of the instant claims does not have reduced flight distance. See paragraph [0041], stating that the instant ball traveled the same distance as the control. Applicants submit that modifying Yang in view of Walker is improper because it would render the prior art unsatisfactory for Walker's intended purpose of reducing flight distance. MPEP § 2145(X)(D).

Eliminating the layer (12) does not achieve a ball having the recited COR limits. In the Response to Arguments on page 6 of the Office Action, the Examiner's remarks were directed to the relative hardnesses of the core and mantle layer(s). Applicants' remarks are directed towards the recited COR limits as distinguishing over the combination of references.

Regarding claim 6, the Examiner stated that it would be obvious to eliminate the layer (14) instead of layer (12) of Yang to produce a harder ball that is capable of absorbing vibrations and shock. The Examiner reasoned on page 6, referring to a different rejection, that eliminating the layer (12) amounts to a mere elimination of parts and its associated function. Applicants note that Yang teaches that it is his third layer 14 that forms a soft cushioning layer to prevent the player from being hurt by the baseball. Based on the Examiner's reasoning, eliminating layer (14) would eliminate the function of preventing the player from being hurt by the baseball. Note that Yang associates this function only with layer (14), not layer (12) as well. In other words, the resulting ball is not a safety ball. The Examiner thus renders Yang (and Talarico and Walker) unsuitable for its intended purpose of not hurting the player. MPEP § 2145(X)(D).

Yang further teaches away from the Examiner's modification in describing the prior art. In col. 1, lines 9-12, Yang discusses the baseball of Heald, Jr. which has a hard cover and a soft cover inside the hard cover. He states that the hard cover may hurt the player. In other words, he teaches away from having a harder layer outside a soft layer. However, this is exactly the situation that arises under the Examiner's modification. Therefore, Yang teaches away from modifying the references as the Examiner has. MPEP § 2145(X)(D).

The references do not provide motivation for making a core with the recited COR limits. All of the references also teach away from the elimination of layer (14). Therefore, the instant claims are not obvious. Applicants request withdrawal of the 103(a) rejection over Yang, Talarico, and Walker.

Claims 9, 17, and 22-34 were rejected under 35 U.S.C. 103(a) over the combination of Yang, Talarico, Walker, and Morgan (4,772,019). Applicants traverse the rejection.

Claims 9, 17, and 23-34 are all dependent claims. Claims depending from a non-obvious claim are also non-obvious. MPEP § 2143.03; *In re Fine*.

Claim 22 is an independent claim that recites COR limits. As discussed above, Yang, Talarico, and Walker do not disclose the recited COR limits. Morgan does not appear to remedy this deficiency. Morgan does not appear to provide motivation for eliminating the layer (14) from the ball of Yang either. Applicants further note that Morgan intends to provide a ball with limited flight characteristics; col. 4, lines 60-65. For these reasons, Applicants submit these claims are non-obvious. Applicants request withdrawal of the 103(a) rejection over Yang, Talarico, Walker, and Morgan.

Applicants wish to emphasize the combination of performance and feel which are available with the instant claims. As discussed in paragraph [0041], the ball of the instant claims feels softer, but travels the same distance. On the other hand, the safety balls of the four references should not travel a long distance. It is the combination of characteristics which is patentable over the references cited by the Examiner.

### **CONCLUSION**

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-11, 13-18, and 20-35) are now in condition for allowance.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

December 6, 2006  
Date

/s/ Richard M. Klein  
Richard M. Klein, Reg. No. 33,000  
1100 Superior Avenue, Seventh Floor  
Cleveland, OH 44114-2579  
216-861-5582

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being	
<input type="checkbox"/>	deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
<input checked="" type="checkbox"/>	transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below.
	Signature: <i>Lynda S. Kalemba</i>
Date: December 6, 2006	Name: Lynda S. Kalemba

N:\RUSS\200050\GXH0000539V001.doc